



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address : COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	INVENTOR NAME	ATTORNEY DOCKET NO.
---------------	-------------	---------------	---------------------

07/130,070 12/08/87 WARD

D ENZ-1 (CONT) D

EXAMINER

MARSCHER, A

ART UNIT

PAPER NUMBER

9

187

DATE MAILED:

12/19/90

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 9/10/90 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), ~~days~~ from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 104-109, 113-118, 125-137, and 140-144 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 104-109, 113-118, 125-137, and 140-144 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group 180, Art Unit 187.

Applicant's election with traverse of Group II in Paper No. 8 is acknowledged. The traversal is on the ground(s) that the hybridizing step of Group I is an antecedent step to forming the complex. This has been found persuasive and therefore the restriction requirement previously applied is hereby removed with the rejoining of the two Groups into one Group for examination on the merits.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and/or use the invention, i.e. failing to provide an enabling disclosure.

Several claims have structures taped onto the page containing the remainder of the claim. The specification including the claims must consist of single continuous sheets without taped on pieces. Correction is required. The claims with taped on pieces are: 125 and 140.

Claims 125 and 140 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claims 104, 106-109, 113-118, 125-137, and 140-144 are

rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is enabling only for claims limited to "A" being either biotin or iminobiotin as given in claim 105. Undue experimentation would be needed to synthesize and practice other moieties. M.P.E.P. §§ 706.03(n) and 706.03(z).

Claims 104-109, 113-118, 125-137, and 140-144 are rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is enabling only for claims limited to specific linker groups that are usable without inhibiting the hybridizability of the resultant polynucleotide. Undue experimentation would be required to synthesize and test other linkers than specifically enabled. See M.P.E.P. §§ 706.03(n) and 706.03(z).

Claims 104-109, 113-118, 125-137, and 140-144 are rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is enabling only for claims limited to the practice of "bound" being hybridization ("bound" is in the last line of claim 125). No other binding is disclosed. See M.P.E.P. §§ 706.03(n) and 706.03(z).

Claims 104-109, 113-118, 125-137, and 140-144 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Line 8 of claim 125 cites the phrase "it is attached" without a clear antecedent basis for the pronoun "it". Does "it" mean the moiety "A" or some other composition?

Claim 113 depends from claims 1 or 47, both of which are

canceled claims making the dependency improper.

Any inquiry concerning this communication should be directed to Ardin Marschel, Ph.D., at telephone number: (703) 308-0196.

AM

A. MARSCHEL:am

December 14, 1990



ROBERT A. WAX
SUPERVISORY PATENT EXAMINER
ART UNIT 187